

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte VINC L. AULICK

Appeal No. 2003-1554
Application No. 09/552,063

ON BRIEF

Before ABRAMS, FRANKFORT and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-19, which are all of the claims pending in this application.

We AFFIRM-IN-PART and denominate this affirmance as a new ground of rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a self-contained hydraulic power unit which does not require hydraulic power supplied from an external source and which may be used on a grain trailer or the like to power the lift cylinder on the dump unit, power the conveyor, power the hydraulic floor or power the end gate (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Bullinger	3,834,767	Sep. 10, 1974
Nelson	3,866,935	Feb. 18, 1975
Bobka	4,030,751	Jun. 21, 1977
Streeter	4,141,582	Feb. 27, 1979
Hamel	4,351,377	Sep. 28, 1982
Tharaldson	5,409,344	Apr. 25, 1995
Anderson, Jr. et al. (Anderson)	5,551,796	Sep. 3, 1996
Clark	5,839,568	Nov. 24, 1998

The following rejections are before us for review.

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamel in view of Anderson, Nelson and Bullinger.

Claims 4 and 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamel in view of Anderson, Nelson and Bullinger and further in view of Streeter.

Claims 5 and 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamel in view of Anderson, Nelson and Bullinger and further in view of Bobka.

Claims 6, 7 and 14-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamel in view of Anderson, Nelson and Bullinger and further in view of Tharaldson and Clark.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 13) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 12 and 14) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Each of appellant's claims recites a hydraulic power unit comprising, inter alia, a hydraulic pump, a valve and a hydraulic accumulator, with the accumulator having an inlet/outlet port which is fluidly connected both to the discharge side of the pump and to

the inlet side of the valve. The examiner concedes on page 3 of the answer that Hamel, the primary reference relied upon in rejecting the claims, lacks this feature. As illustrated schematically in Figure 7, Hamel's accumulator is connected to both the discharge side of the pump and the inlet side of the valve. Rather than showing a single inlet/outlet port, however, Hamel's Figure 7 appears to show an inlet of the accumulator connected to the discharge side of the pump and a separate outlet connected to the inlet side of the valve.

To overcome this deficiency, the examiner points to the teaching in Anderson (note Figure 5) of a hydraulic power unit comprising an accumulator 531 having a single inlet/outlet line 533 fluidly connected to the discharge side of a pump 525 and the inlet side of a solenoid valve 515. It appears to be the examiner's position that it would have been obvious to one of ordinary skill in the art to replace the accumulator of Hamel, with its separate inlet and outlet ports, with an accumulator as taught by Anderson, with a single inlet/outlet port connected to the discharge side of the pump and to the inlet side of the valve. According to the examiner, "[t]he motivation is the known use of equivalents" (answer, page 4).

As pointed out by appellant on page 6 of the brief, the mere fact that the prior art could be modified as proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re

Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Appellant (brief, page 6) is correct that, “[i]n order for an Examiner to rely on equivalents as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art.” See In re Ruff, 256 F.2d 590, 598, 118 USPQ 340, 347 (CCPA 1958). Further, rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

In this case, the examiner has not supplied any evidence¹ to support his contention that the accumulator arrangement of Anderson is a known equivalent to the arrangement taught by Hamel. We thus conclude that the examiner’s rationale in determining that the subject matter of appellant’s claims would have been obvious is flawed and we cannot sustain the rejections on this basis. The examiner’s rejections of claims 2-19 under 35 U.S.C. § 103 are therefore reversed.

¹ The additional references to Nelson (relied upon for its teaching of a battery-powered pump), Bullinger (relied upon for its teaching of a wheel-driven pump for use in an auxiliary hydraulic brake system), Streeter (relied upon for its teaching of a cylinder-operated tail gate), Bobka (relied upon for its teaching of a cylinder-operated dump bed on a portable trailer), Tharaldson (relied upon for its teaching of a portable grain cart auger system) and Clark (relied upon for its teaching of a reciprocating floor on a trailer) do not overcome this deficiency.

We do note, however, that claim 1 reads on Anderson in the following manner. Anderson discloses a self-contained hydraulic power unit for powering a hydraulic cylinder 223 comprising a hydraulic pump 525, a solenoid valve 515, a hydraulic reservoir tank 511 and a hydraulic accumulator 531 having a single inlet/outlet port (note line 533). As illustrated in Figure 5, the inlet side of the tank 511 is fluidly connected to the return side of the valve 515 via line 521, the outlet side of the tank 511 is fluidly connected to the inlet side of the pump 525 via line 527, the discharge side of the pump 525 is fluidly connected to the inlet/outlet port on the accumulator 531 via line 533, the inlet/outlet port of the accumulator 531 is fluidly connected to the inlet side of the valve 515 via lines 533 and 535 and the outlet side of the valve 515 is fluidly connected to the hydraulic cylinder 223 via lines 517 and 519.

As Anderson, one of the references relied upon in rejecting claim 1 under 35 U.S.C. § 103, discloses each and every limitation of claim 1, as detailed above, Anderson anticipates claim 1 under 35 U.S.C. § 102(b). A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641,

644 (CCPA 1974). Thus, we sustain the examiner's rejection of appealed claim 1 under 35 U.S.C. § 103. As is apparent from our discussion above, however, our rationale in affirming this rejection differs substantially from the examiner's stated rationale in rejecting claim 1. We thus denominate our affirmance of this rejection as a new ground of rejection under 37 CFR § 1.196(b) in order to give appellant an opportunity to respond thereto.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-19 under 35 U.S.C. § 103 is affirmed as to claim 1 and reversed as to claims 2-19. The affirmance of the decision to reject claim 1 is denominated as a new ground of rejection pursuant to 37 CFR § 1.196(b) for the reasons discussed above.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b), which provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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